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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,557	12/21/2001	Takuya Ogane	2185-0607P	3620

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EXAMINER	
LEE, RIP A	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/024,557	OGANE, TAKUYA
	Examiner	Art Unit
	Rip A. Lee	1713

-- The MAILING DATE of this communication appears on the cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☒ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This office action follows a response filed on July 31, 2003. Applicants have amended claims 1-3, 5, 6, and 8-10 to correct matters of form.

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(b) as follows: certified copies of JP 2000-395776, JP 2001-194575, and JP 2001-194576 have not been received.

Claim Objections

2. Claim 7 is objected to because of the following informalities: Change "obtainable" to "obtained." Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "homogeneous type" is a relative term that renders the claim indefinite. See MPEP 2173.05(b). First, a catalyst is considered homogeneous or heterogeneous. If the catalyst is not homogeneous, then it is heterogeneous. It is not "homogeneous type," as Applicants choose to label their catalyst. Secondly, while Applicant may be his/her own lexicographer, such license doe not extend to terms which are contrary, or "repugnant" to the usual meaning of the term. *In re Hill*, 161 F.2d 367, 73 USPQ 483 (CCPA 1947).

In this case, the catalyst contains two components: a particle and an organometallic complex. Clearly, the catalyst is heterogeneous. As such, the catalyst is not homogeneous, nor is it "homogeneous type." As such, it is not clear what is meant by the term "homogeneous type."

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,344,528 to Ushioda *et al.* for the same reasons set forth in the previous office action (Paper No. 6).

7. Claims 1-4 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,054,406 to Smith for the same reasons set forth in the previous office action.

Response to Arguments

8. The Applicants traverse the rejection of claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,344,528 to Ushioda *et al.* and the rejection of claims 1-4 and 9-12 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,054,406 to Smith.

Applicants submit that the claim language of "removing a solid substance" defines the invention and that the prior art does not teach removal of the solid substance. Applicants maintain that the cited prior art allows for removal of supernatant, and therefore, attention is paid so as *not* to remove solid substance.

Whether the references teach "not removing solid substance" remains to be seen, since no passage stating this specifically exists in either reference. What the references do not show is that the supernatant does not contain of "fine-powdery component" and "shapeless component." However, in view of the fact that the steps outlined in the prior art are essentially the same as that described in the present claims, there is no reason to believe that the supernatant is devoid of such material. That is, where processes are essentially the same, a reasonable basis exists to believe that "fine-powdery component" and "shapeless component" are formed in the catalyst preparation step. The burden of proof was shifted to the Applicants to establish an unobviousness difference. To date, Applicants have not furnished evidence to the contrary. Lastly, the finely divided, flocculent material, which does not settle, would be removed, as per the steps outlined in the present invention (see Examples).

In view of the discussion above, the rejections of record have not been withdrawn.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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October 6, 2003

DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700